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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/654,929	09/05/2000	Ryota Akiyama	1046.1100RE	7584
21171	7590	06/03/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			DIXON, THOMAS A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/654,929

Applicant(s)

AKIYAMA ET AL.

Examiner

Thomas A. Dixon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/15/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments are not convincing, the rejections are maintained.
2. The removal of the feature "software management means for decoding encrypted software data and for managing monetary charges according to the usage of the software data" that was argued by applicant as the distinguishing features of the claims in amendment C, filed 8 December 1997, of the parent application is seen as a broadening, even though applicant has added language that applicant argues narrows the claims in another aspect. Dependent claims 10, 14, 18, 26, 30, 34 contain aspects of managing monetary charges according to usage and would remedy the rejection.
3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

new rejections regarding improper recapture follow.

Improper Recapture

4. Claims 8-39 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Specifically, the "software management means for decoding encrypted software data and for managing monetary charges according to the usage of the software data", were argued by applicant as the distinguishing features of the claims in amendment C, filed 8 December 1997, of the parent application, and therefore constitute improper recapture.

Reissue Applications

5. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Oath/Declaration

6. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

a. It does not state whether the inventor is a sole or joint inventor of the invention claimed.

b. The nature of the defect(s) in the declaration is that the error set forth as the basis for the Reissue application is based on improper recapture. Specifically, the "input switchover" and "output switchover", argued as the error which forms the basis for the reissue application, were added to the original claims and argued by applicant as the distinguishing features of the claims in both amendments B, filed 6 May 1997, and C, filed 8 December 1997, of the parent application. Therefore, correction constitutes improper recapture and cannot form the basis of a reissue application.

7. Claims 1-36 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

Allowable Subject Matter

8. Claims 1-7 are allowable over the prior art.

9. Claims 8-36 are allowable over the prior art, but are seen to be improper recapture.

10. The following is an examiner's statement of reasons for allowability:

As per Claims 1, 4, 6, 7.

The prior art of record, specifically, Arnold et al (176) in view of Hartman Jr ('166) does not disclose:

a software management means for decoding encrypted software data and for managing monetary charges according to the usage of the software data; and

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output switchover means for receiving encrypted data from said input switchover means and outputting the encrypted data to said software management means, and for receiving non-encrypted software data from said input switchover means and outputting the non-encrypted software data to said data conversion section as claimed, but remain rejected to under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

Claims 8, 12, 23, 24, 28, 39.

The prior art of record, specifically Shear ('598) in view of Allen ('713) do not disclose a switch means for switching a one-way connection between said digital information receiving means and said information converting means, said digital information receiving means and said drive means, and said drive means and said information converting means, as claimed.

Claims 16, 21, 22, 32, 37, 38.

The prior art of record, specifically Shear ('598) in view of Allen ('713) do not disclose first, second and third switches for switching a one-way connection between said digital information receiving means and said information converting means, said digital information receiving means and said drive means, and said drive means and said information converting means, as claimed.

Claims 20.

The prior art of record, specifically Shear ('598) in view of Allen ('713) do not disclose first, second, third and fourth switches for switching a one-way connection between said digital information receiving means and said information converting means, said digital information receiving means and said drive means, and said drive means and said information converting means, as claimed.

Claims 36.

The prior art of record, specifically Shear ('598) in view of Allen ('713) do not disclose first, second, third, fourth and fifth switches for switching a one-way connection between said digital information receiving means and said information converting means, said digital information receiving means and said drive means, and said drive means and said information converting means, as claimed.

The claims that depend from the above allowable claims are allowable for the same reasons.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Thomas A. Dixon" with a stylized flourish at the end.

Thomas A. Dixon
Primary Examiner
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